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09/737,697	12/14/2000	Thomas H. Slaight	10-00-001	1400
7590	07/07/2004		EXAMINER	
David G. Wille Suite 600 2001 Ross Avenue Dallas, TX 75201-2980			SNAPP, SANDRA S	
			ART UNIT	PAPER NUMBER
			3624	

DATE MAILED: 07/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/737,697

Applicant(s)

SLAIGHT ET AL.

Examiner

Sandra Snapp

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MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>2 &amp; 3</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

The Examiner acknowledges the Applicant claims priority to provisional application serial no. 60/173,573, filed 12-29-1999.

### ***Information Disclosure Statement***

The information disclosure statements (IDSs) submitted on 12-14-00 and 01-22-04 were filed in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements were considered by the examiner.

### ***Drawings***

The drawings are objected to because there is a Fig. 12, but no Fig. 12A. There is a figure description for Fig. 12A, but no Fig. 12. The figure descriptions and the drawings should be consistent. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional

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replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

The disclosure is objected to because there is a figure description for Fig. 12, but no Fig. 12 in the drawings. There is a Fig. 12A in the drawings and no corresponding figure description therefor. Either the drawings need to be amended to match the specification (figure descriptions) or the specification (figure descriptions) need to be amended to match the drawings. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10, 12, 20 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-10 are indefinite because

Claim 9 is also indefinite because

Claim 12 is indefinite because

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Claim 20 is indefinite because

Claim 24 is indefinite because

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-10 are directed to non-statutory subject matter because they lack any recitation of technology in the body of the claims, which is required in order to meet the statutory requirements. The Patent Office had taken the position that some form of technology must be claimed in the body of the claim. The Board of Patent Appeals and Interferences has stated that claims lacking any technology are “nothing more than [an] abstract idea which is not tied to any technological art and is not a useful art as contemplated by the Constitution.” *Ex parte Bowman*, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) (Unpublished). While it is understood that the Bowman case is not precedential, it is cited herein for its content and reasoning. The Examiner suggests amending the claims to include some reference to a computer in the body of the claims to overcome this rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-12, 14 and 16-32 are rejected under 35 U.S.C. 102(b) as being anticipated by the Gindlesperger patent (US 6,397,197 B1).

The Gindlesperger reference discloses an electronic bidding system, comprising:

Means for enabling each of a plurality of vendors to submit bids on at least two parameters associated with a product (col. 7, line 60 through col. 8, line 2), means for calculating the total cost of the product to a purchaser for each vendor in response to the vendors bids, the total cost taking into account the at least two parameters associated with the product (col. 5, lines 28-35), and means for outputting each of the vendors bids and the total cost of the product to the purchaser (col. 7, line 60 through col. 8, line 2) (claim 1);

The bids includes a plurality of parameters for the product and the total cost calculating means determines the total cost of the product to the purchaser using a pre-determined total cost formula (col. 7, line 60 through col. 8, line 2) (claim 2);

The total cost formula includes at least one pre-defined constant (col. 7, line 60 through col. 8, line 2) (claim 3);

Means for enabling communication with the vendors during the bidding (col. 5, lines 11-27) (claim 6);

The communication means enables messages to be sent to the vendors to encourage further bidding by the vendors (col. 5, lines 11-27) (claim 7);

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The communication means enables messages to be sent to the vendors regarding the status of the bidding, ending time for the bidding and extensions of the bidding (col. 5, lines 28-35) (claim 8);

Means for calculating the amount of savings for the purchaser and means for communicating the savings to the purchaser (col. 3, lines 30-37) (claim 9); and

Means for setting up the bidding on the product (col. 4, line 55 through col. 5, line 10) (claim 10).

The Gindlesperger reference discloses an electronic auction system, comprising:

A computer readable storage medium (inherent in computer system having storage means such as a database, col. 5, lines 10-14), and software (inherent in a computer system) stored on the computer readable storage medium and operable to receive bids from a plurality of vendors, each bid comprising a plurality of parameters associated with at least one product, calculate the total cost of the at least one product to a purchaser for each vendor in response to the vendors' bids, the total cost taking into account the plurality of parameters associated with the at least one product, and output each of the vendors bids and the total cost of the product to the purchaser (col. 7, line 60 through col. 8, line 2 and col. 5, lines 28-35) (claim 11);

The at least two parameters are selected from the group consisting of price, discount, delivery, installation, training, maintenance, the risks covered by warranty, and length of warranty (col. 2, lines 24-37) (claim 12);

The software is further operable to send data to the vendors during the bidding to stimulate competitive bidding (col. 5, lines 11-27) (claim 14);

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The total cost calculated for each vendor uses a single formula for all vendors (col. 7, line 60 through col. 8, line 2) (claim 16);

The total cost calculated for each vendor uses a plurality of formulas, each vendor having one of the plurality of formulas associated with it (col. 7, line 60 through col. 8, line 2) (claim 17);

The plurality of parameters is further associated with a plurality of products (col. 6, line 65 through col. 7, line 16) (claim 18);

The auction results take into account vendors bids on a market basket of prices (col. 6, lines 65 through col. 7, line 16) (claim 19);

Bids from vendors are received through the Internet (col. 7, lines 17-22) (claim 20);

The software is further operable to provide a vendor with data about the status of an auction while the auction is in progress (col. 5, lines 28-35) (claim 21);

The software is further operable to provide a purchaser with data about the status of an auction while the auction is in progress (col. 8, lines 7-9) (claim 22);

The software is further operable to control which vendors are allowed to participate in an auction (col. 5, lines 11-24) (claim 23); and

The software is further operable to allow a total cost formula to be defined for each product in an auction (col. 7, line 60 through col. 8, line 2) (claim 24).

The Gindlesperger reference disclose a method of conducting an on-line auction comprising:

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Receiving bids from a plurality of vendors (col. 5, lines 18-23), each bid comprising a plurality of parameters associated with at least one product, calculating, using a computer, the total cost of the at least one product to a purchaser for each vendor in response to the vendors' bids, the total cost taking into account the plurality of parameters associated with the at least one product, and outputting, using the computer, each of the vendors bids and the total cost of the product to the purchaser (col. 7, line 60 through col. 8, line 2) (claim 25);

Defining a plurality of parameters for a category of products (col. 7, line 60 through col. 8, line 2), and defining a total cost formula for the category of products in response to the plurality of parameters (col. 7, line 60 through col. 8, line 2) (claim 26);

The total cost formula includes at least one constant associated with at least one parameter (col. 7, line 60 through col. 8, line 2) (claim 27);

The plurality of parameters includes prices and non-price parameters (col. 7, line 60 through col. 8, line 2 and col. 2, lines 24-37) (claim 28);

The price parameters include at least one of a base price, volume, discounts, rebates, life cycles discounts, utilization charges, maintenance charges and administration charges (col. 7, line 60 through col. 8, line 2 and col. 2, lines 24-37) (claim 29);

The non-price parameters include at least one of a delivery timing, national service coverage, minimum quality levels, employee skill levels, a dedicated account management team, special reporting requirements, online ordering, warranty and length of contract (col. 2, lines 24-37) (claim 30);

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Defining a plurality of parameters comprises defining at least two sub-categories for the category of products, and defining at least two parameters for each subcategory (col. 1, lines 27-67) (claim 31); and

Communicating the best vendor's bid to the other vendors to encourage competitive bidding (col. 5, lines 28-35) (claim 32).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

*Claims 4, 5, 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gindlesperger patent as applied to claims 1, 11 and 25 above, and further in view of the Adams patent (US 3,573,747).*

The Gindlesperger patent discloses all the elements of the present invention, as stated above, except for:

Means for communicating a vendor bid having the best total cost for the product to the vendors without revealing the identification of the vendor with the best total cost to encourage competitive bidding by the other vendors (claim 4);

Means for enabling the purchaser to make at least one adjustment corresponding to at least one of the vendor bids which is used by the calculating means to determine the total cost of the product to the purchaser (claim 5);

The software is further operable to send data, comprising a vendor bid having the best total cost for the product, to the vendors during the auction without revealing the identification of the vendor with the best total cost (claim 13); and

The software is further operable to enable the purchaser to make at least one adjustment corresponding to at least one vendor bid which is used by the central auction management system to calculate the total cost of the product to the purchaser (claim 15).

The Adams patent teaches:

Means for communicating a vendor bid, and software operable to send data having the best total cost for the product to the vendors without revealing the identification of the vendor with the best total cost to encourage competitive bidding by the other vendors (A-Abstract) (claims 4 and 13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Gindlesperger system to include the teachings of the Adams patent so as to provide the vendors keep the vendors informed of the status of the process, while ensuring a secure and fair environment.

The Adams patent also teaches:

Means, and software, for enabling the purchaser to make at least one adjustment corresponding to at least one of the vendor bids which is used by the calculating means to determine the total cost of the product to the purchaser (A-col. 10, liens 48-53) (claims 5 and 15).

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the Gindlesperger system to include the teachings of the Adams patent so as to allow the purchaser to make modifications in case there are discrepancies and/or errors, and to allow the transactions in the system to be modified so as to ensure all the available quantities are bought and sold.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Gindlesperger, Reddi, Sheth, Quallen et al., Abdou, Posner, Nymeyer, Barr et al., Barnes et al., Silverman et al., Fraser et al., Hoffer, Micali, Sirbu et al., Fisher et al. and Ausubel patents and applications are all directed to various types of electronic commerce and/or auction systems.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra Snapp whose telephone number is 703-305-6940. The examiner can normally be reached on Mon.-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 703-308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SS

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